

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 45, 49 and 52-58 are pending in the application, with claims 45 and 53 being the independent claims. Claims 46-48 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. New claims 53-58 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. Support for Amended and New Claims

Support for amended claim 45 can be found, *inter alia*, in the specification at page 38, lines 9-26, at page 39, line 5, through page 40, line 22, and in original claim 46. Support for new claims 53-58 can be found, *inter alia*, in the specification at page 35, line 17, through page 38, line 8, at page 39, line 5, through page 40, line 22, and in original claims 47-49 and 52.

II. Claim Rejections Under 35 U.S.C. § 102

A. WO 96/32500 (Todd)

Claims 45-49 and 52 were rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by International Patent Publication No. WO 96/32500 (hereinafter "Todd"). *See* Paper No. 14, page 3. Applicants respectfully traverse this rejection and submit that the rejection is moot in view of the amended and new claims presented above.

Amended claim 45 is directed to a composition comprising one or more restriction endonucleases and one or more polymerase inhibitors, wherein said one or more polymerase inhibitors are selected from the group consisting of: an antibiotic, a heavy metal, an acid, a nucleotide analogue, an anionic detergent, a polyanion, captan ((N-[trichloromethyl]-thio)-4-cyclohexene-1,2-dicarboximide), an acidic polysaccharide, a binding protein or peptide, and combinations thereof; wherein said composition does not contain any nucleic acid molecules.

Claims 46-48 have been canceled. New claims 53-56, however, are directed to subject matter related to that which was encompassed by claims 46-48. In particular, new claims 53-56 are directed to compositions comprising one or more restriction endonucleases and one or more polymerase inhibitors, wherein said one or more polymerase inhibitors are one or more antibodies or fragments thereof, and wherein said composition does not contain any nucleic acid molecules.

Under 35 USC § 102, a claim can only be anticipated if every element in the claim is expressly or inherently disclosed in a single prior art reference. *See Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984); *see*

also PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996) ("[t]o anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.")

A provision found in both amended claim 45 and new claim 53 is that the claimed compositions do not contain any nucleic acid molecules. The PCR reaction mixture described in Todd at page 22, lines 8-21, by contrast, includes nucleic acid molecules in the form of genomic DNA and oligonucleotide primers. Thus, Todd does not describe compositions having all of the features of claims 45, 53 and the claims that depend therefrom (claims 49, 52 and 57, and claims 54-56 and 58, respectively). Applicants therefore respectfully request that the rejection under 35 U.S.C. § 102(a), based on the disclosure of Todd, be reconsidered and withdrawn.

B. Life Technologies Catalogue and Reference Guide

Claims 45, 46, 49 and 52 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by GibcoBRL Life Technologies Catalogue and Reference Guide (hereinafter "GibcoBRL Catalogue"). Applicants respectfully traverse this rejection and submit that the rejection is moot in view of the amended and new claims presented above.

Amended claim 45 specifies, among other things, that "said one or more polymerase inhibitors are selected from the group consisting of: an antibiotic, a heavy metal, an acid, a nucleotide analogue, an anionic detergent, a polyanion, captan ((N-[trichloromethyl]-thio)-4-cyclohexene-1,2-dicarboximide), an acidic polysaccharide, a binding protein or peptide, and combinations thereof." The restriction enzyme compositions disclosed in the GibcoBRL Catalogue do not contain any of the types of polymerase inhibitors specified by claim 45.

Thus, the GibcoBRL Catalogue cannot and does not anticipate claim 45 or the claims that depend therefrom (claims 49, 52 and 57). Applicants therefore respectfully request that the rejection under 35 U.S.C. § 102(a), based on the teachings of the GibcoBRL Catalogue, be reconsidered and withdrawn.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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Version with markings to show changes made

45. (Thrice amended) A composition comprising one or more restriction endonucleases and one or more polymerase inhibitors, wherein said one or more polymerase inhibitors are selected from the group consisting of: an antibiotic, a heavy metal, an acid, a nucleotide analogue, an anionic detergent, a polyanion, captan ((N-[trichloromethyl]-thio)-4-cyclohexene-1,2-dicarboximide), an acidic polysaccharide, a binding protein or peptide, and combinations thereof; wherein said composition does not contain any nucleic acid molecules.

Claims 46-48 are sought to be canceled.

Claims 53-58 are sought to be added.